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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,133	12/01/2000	Bruce Bryan	24729-105F	3075

7590

03/14/2003

ALAN G. TOWNER
PIETRAGALLO, BOSICK & GORDON
ONE OXFORD CENTRE
38th FLOOR
PITTSBURGH, PA 15219

EXAMINER

PROUTY, REBECCA E

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 03/14/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,133

Applicant(s)

Bryan

Examiner

Rebecca Prouty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 11, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) 4, 6, 7, and 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other: _____

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Applicant's election of the species of bubbles, bubble making toys or bubble bath in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 4, 6, 7, and 15-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 8.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5, and 8-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being

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unpatentable over claims 1, 6, 7, 10 and 16-20 of U.S. Patent No. 6,113,886. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because each recite a combination which is a novelty item comprising an article of manufacture and a fluorescent protein. The claims differ in that in the patent the article of manufacture is limited to personal care items, dentrifices, soaps, body paints and powders, and bubble baths while in the instant case it can be anything (Claims 1 and 8-14) or selected from a variety of Markush groups of differing scope all of which include bubble baths (Claims 2, 3, and 5). The claims also differ in that the claims of the patent also recite a combination which is a novelty item comprising an article of manufacture and at least one component of a bioluminescence generating system (i.e.,

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luciferase, luciferin and any other components necessary to produce luminescence) which are not recited in the claims of the instant case. It would have been obvious to one of ordinary skill in the art to select any of the specifically defined embodiments of the Markush group recited in the claims of the prior patent which include a combination which is a novelty item comprising bubble bath and a fluorescent protein (in particular a green fluorescent protein, a blue fluorescent protein or a phycobiliprotein) optionally further comprising a delivery vehicle which is a liposome, a gelatin capsule, micronized particles, a time release vehicle or water soluble. This specific embodiment of the claims of the prior patent anticipates the claims of the instant application.

Claims 1-3 and 8-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28, 29, 33, 34, and 37 of U.S. Patent No. 5,876,995. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226

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(Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 28 and 29 of the prior patent anticipate Claims 1 and 2 of the instant application, Claims 33 and 34 of the prior patent anticipate Claims 8 and 12 of the instant application and Claim 37 of the prior patent anticipates Claims 14 of the instant application. Claim 3 of the instant application would have been obvious to one of ordinary skill in the art from Claim 28 of the prior patent as the portion of the specification of the prior patent that supports the genus of foods of Claim 28 (column 66 line 43 - column 70 line 16) teaches that foods includes ice. As such it would have been obvious to select ice as the food in the combination of Claim 28 of the prior patent. Claims 9-11 and 13 of the instant application would have been obvious to one of ordinary skill in the art from Claim 33 and 34 of the prior patent as the portion of the specification of the prior patent that supports the genus of time-release vehicles of Claims 33 and 34 (column 37 line 33 - column 40 line 46) teaches that suitable delivery vehicles for the include specifically liposomes, gelatin capsules, micronized particles and other water soluble vehicles.

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As such it would have been obvious to select any of liposomes (Claim 9), gelatin capsules, (Claim 10) micronized particles, (Claim 11) and other water soluble vehicles (Claim 13) as the time-release vehicle in the combinations of Claims 33 and 34 of the prior patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 8, 10, and 12-14 rejected under 35 U.S.C. 103(a) as being unpatentable over PROMT Accession No. 92:493162 or PROMT Accession No. 92:493161 in view of Prasher et al. (Gene 111: 229-332. 1992, Reference TQ of Applicant's PTO-1449).

PROMT Accession No. 92:493162 and PROMT Accession No. 92:493161 disclose a Belvedere International Inc. fluorescent green (or purple or orange) bubble bath product which fluorescent color is produced by a fluorescent green dye. This bubble bath is marketed to children.

Prasher et al. teach the *Aequorea victoria* green-fluorescent protein. Prasher et al. teach that this protein is highly

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fluorescent and stable even to a variety of harsh conditions including heat, extreme pH and chemical denaturants (page 230).

It is well known in the art that children's bath products, such as bubble bath must be non-toxic, non-irritating, and should contain preferably contain only biodegradable components such that after use they do not contribute to pollution of the environment. Therefore, it would have been obvious to one of ordinary skill in the art to use the green fluorescent protein of Prasher et al. as the fluorescent component in the bubble bath of PROMT Accession No. 92:493162 or PROMT Accession No. 92:493161 as proteins are both non-toxic and biodegradable products and Prasher et al. teach that GFP is particularly stable under a variety of conditions making it ideal for use in a product which may be stored under a variety of conditions by consumers. Furthermore, although the bubble baths of PROMT Accession No. 92:493162 and PROMT Accession No. 92:493161 appear to have the fluorescent component added directly to the bubble bath, it would have been obvious to one of skilled in the art that the fluorescent component could be provided in a separate vehicle such as a water soluble capsule which could be added to the bubble bath at the time of use. This would be expected prevent any degradation of the fluorescent component prior to use and would allow the consumer to choose on which occasions to add the

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fluorescent component to the bubble bath such that it could be saved only for those occasions in which the fluorescent effect is desired.

Claims 1-3, 5, 8, 10, and 12-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Halbritter in view of Prasher et al. (Gene 111: 229-332. 1992, Reference TQ of Applicant's PTO-1449).

Halbritter disclose bubble making solutions comprising a chemical chemiluminescent generating system. They disclose that the bubble solution and one or more components of the chemiluminescent system should preferably be packaged separately and mixed just prior use.

Prasher et al. teach the *Aequorea victoria* green-fluorescent protein. Prasher et al. teach that this protein is highly fluorescent and stable even to a variety of harsh conditions including heat, extreme pH and chemical denaturants (page 230).

It is well known in the art that children's toys, such as bubble blowing products should be non-toxic and should contain preferably contain only biodegradable components such that after use they do not contribute to pollution of the environment. Therefore, it would have been obvious to one of ordinary skill in the art to use the green fluorescent protein of Prasher et al. as

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the fluorescent component in the bubble solution of Halbritter as proteins are both non-toxic and biodegradable products and Prasher et al. teach that GFP is particularly stable under a variety of conditions making it ideal for use in a product which will include surfactants and may be stored under a variety of conditions by consumers. Furthermore, as Halbritter teach that preferably the one or more of the light producing components should preferably be packaged separately and mixed just prior use, it would have been obvious to one of skilled in the art that the fluorescent component could be provided in a separate vehicle such as a water soluble capsule which could be added to the bubble solution at the time of use. This would be expected prevent any degradation of the fluorescent component prior to use and would allow the consumer to choose on which occasions to add the fluorescent component to the bubble solution such that it could be saved only for those occasions in which the fluorescent effect is desired.

The references not initialed of applicants information disclosure statement filed 2-9-01 were not considered because no copy of these references was provided or is found within applicant's parent applications. The examiner acknowledges that most of these references were provided in the parent applications but they are no longer present within the parent cases. If

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applicants wish this information to be considered copies of each reference are requested.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Rebecca Prouty
Primary Examiner
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